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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/043,662 | 01/09/2002 | Fletcher L. Chapin | END920010017US1 | 8236 |
| 23550 | 7590 | 02/11/2005 | EXAMINER | |
| HOFFMAN WARNICK & D'ALESSANDRO, LLC 3 E-COMM SQUARE ALBANY, NY 12207 | | | PRONE, JASON D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3724 | |

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/043,662 | CHAPIN ET AL. <i>CD</i> | |
| | Examiner | Art Unit | |
| | Jason Prone | 3724 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 December 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5,7-9,21-23 and 29-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,7-9,21-23 and 29-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 29, and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiyoshi (JP5138595) (See page 10 of this office action for the examiner added reference labels used for clarity in the rejection below).

In reference to claims 1-5 and 28:

Kiyoshi (JP5138595) discloses the same invention including a machine for detaching a part from a web (15), that the machine includes a die (18a) that includes a die opening (73), a duct (18 and 19) including an interior sloped side (20) and an opposing vertical edge (74) creating a first opening for receiving a part (70), a second opening that is smaller than the first opening (71), and a third opening that is larger than the second opening (72), that the interior sloped side is capable of partially obstructing a first side of the part while allowing a second side of the part to pass unobstructed so that the part exits the third opening in a substantially vertical orientation (Fig. 1), that the duct is coupled to the machine (Fig. 1), that the machine includes a punch (15), that the interior slop is made of one of the group of polymeric material and polished metal (20), that the sloped side is planar (20), and that the at least one edge is opposite the interior sloped side (74).

In reference to claims 29 and 33-35:

Kiyoshi (JP5138595) discloses the same invention including a die (18a) having a die opening (73), that the die comprises a substantially rectangular vertical cross section that allows a part to pass through (18a), a duct disposed below the die opening (18 and 19), that the duct includes an interior sloped side (20) that creates a first opening for receiving the part after the die opening (70) and a second opening that allows the part to pass through (71), that the interior slope partially obstructs a portion of the die opening (Fig. 1) that the interior sloped side is capable of partially obstructing a first side of the part while a second side of the part to passes through the second opening unobstructed so that the part exits the second opening in a substantially vertical orientation (Fig. 1), a punch for detaching the part from a web (15), that the second opening is smaller than the first opening (71), that the interior sloped side creates a third opening that is larger than the second opening (72), and that the first, second and third openings are vertically aligned along an edge opposite the interior slope (74).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyoshi (JP5138595) in view of Amarakoon further in view of Nakayama. Kiyoshi

(JP5138595) discloses the invention but fails to disclose a container including an open end and a convex contoured end, that the open end is coupled to the duct to receive a part from the third opening, that the convex contoured end conforms to a curl shape of the part, that the container accommodates a plurality of parts with a curled shape, and that the container is coupled to the duct using a u-shaped channel. Amarakoon teaches a container including an open end (67), that the open end is coupled to the duct to receive a part from the third opening (67), and that the container is coupled to the duct using a u-shaped channel (Fig. 1). Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kiyoshi (JP5138595) with a container attached with a u-shaped channel, as taught by Amarakoon, to allow for the punched pieces to be stored in a removably attached receptacle for easier disposal.

Nakayama teaches a container including contoured end (40a) and that contoured end conforms to a curl shape of the part (24). Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kiyoshi (JP5138595) in view of Amarakoon with a container with a contoured shape end, as taught by Nakayama, to allow more a more efficient means of stacking.

However, Kiyoshi (JP5138595) in view of Amarakoon further in view of Nakayama fail to disclose that the contoured end has a convex shape. It would have been an obvious matter of design choice to make the different portions of the contoured end of the container of whatever form or shape was desired or expedient, in this case a convex shape. A change in form or shape is generally recognized as being within the

level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. It would have been obvious to have made the end of the container to match the shape of the part it was containing as shown in Figure 7 of Nakayama.

5. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyoshi (JP5138595) in view of Amarakoon further in view of Nakayama. Kiyoshi (JP5138595) discloses the invention including a duct (18 and 19) with an opposing edge having an outer vertical edge (75), an interior sloped side (20), and a support member therebetween (76), an opposing edge (74) that the interior slope and the opposing edge creating a first opening (70), and a second opening (71), and that the interior sloped side partially obstructs a first side of the part while allowing a second side of the part to pass through the second opening unobstructed so that the part exits the second opening in a substantially vertical orientation (Fig. 1) but fails to disclose a container including an open end and a convex contoured end, that the open end is coupled to the duct to receive a part from the second opening, that the convex contoured end conforms to a curl shape of the part, that the container accommodates a plurality of parts with a curled shape, and that the container is coupled to the duct using a u-shaped channel. Amarakoon teaches a container including an open end (67), that the open end is coupled to the duct to receive a part from the third opening (67), and that the container is coupled to the duct using a u-shaped channel (Fig. 1). Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kiyoshi (JP5138595) with a container attached with a u-shaped

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channel, as taught by Amarakoon, to allow for the punched pieces to be stored in a removably attached receptacle for easier disposal.

Nakayama teaches a container including contoured end (40a) and that contoured end conforms to a curl shape of the part (24). Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kiyoshi (JP5138595) in view of Amarakoon with a container with a contoured shape end, as taught by Nakayama, to allow more a more efficient means of stacking.

However, Kiyoshi (JP5138595) in view of Amarakoon further in view of Nakayama fail to disclose that the contoured end has a convex shape. It would have been an obvious matter of design choice to make the different portions of the contoured end of the container of whatever form or shape was desired or expedient, in this case a convex shape. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. It would have been obvious to have made the end of the container to match the shape of the part it was containing as shown in Figure 7 of Nakayama.

6. Claims 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyoshi (JP5138595) in view of Amarakoon. Kiyoshi (JP5138595) discloses the invention but fails to disclose a container disposed below and vertically aligned with the second opening and that the container is coupled to the duct using a u-shaped channel. Amarakoon teaches a container disposed below and vertically aligned with the second opening (67) and that the container is coupled to the duct using a u-shaped channel (Fig. 1). Therefore it would have been obvious to one of ordinary skill in the art, at the

time of the invention, to have provided Kiyoshi (JP5138595) with a container attached with a u-shaped channel, as taught by Amarakoon, to allow for the punched pieces to be stored in a removably attached receptacle for easier disposal.

7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyoshi (JP5138595) in view of Amarakoon as applied to claims 29 and 30 above, and further in view of Nakayama. Nakayama teaches a container including contoured end (40a) and that contoured end conforms to a curl shape of the part (24). Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kiyoshi (JP5138595) in view of Amarakoon with a container with a contoured shape end, as taught by Nakayama, to allow more a more efficient means of stacking.

However, Kiyoshi (JP5138595) in view of Amarakoon further in view of Nakayama fail to disclose that the contoured end has a convex shape. It would have been an obvious matter of design choice to make the different portions of the contoured end of the container of whatever form or shape was desired or expedient, in this case a convex shape. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. It would have been obvious to have made the end of the container to match the shape of the part it was containing as shown in Figure 7 of Nakayama.

8. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kiyoshi (JP5138595) in view of Jakubik. Kiyoshi (JP5138595) discloses the invention but fails to disclose that the duct includes a plurality of substantially parallel interior sloped sides. Jakubik teaches a duct with a plurality of substantially parallel interior sloped sides (83).

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Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Kiyoshi (JP5138595) with a duct with a plurality of substantially parallel interior sloped sides, as taught by Jakubik, to slow the speed of the part exiting the duct.

Allowable Subject Matter

9. Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 13 December 2004 have been fully considered but they are not persuasive. Ducts are clearly defined by their wall structure. In view of this statement, the parts (18, 19, and 20) disclosed by Kiyoshi (JP5138595) are all integral/attached and are considered one whole object or duct. Therefore, the sloped side 20 is part of duct 19. Using Figure 1 of the instant application, the part as a whole is obstructed but the reason the second side is considered unobstructed is because it does not make contact with the sloped side. In Kiyoshi (JP5138595), the part being disconnected from the web has a top and a bottom side. Since the slope side cannot possibly touch both the top and the bottom side at the same time, the not touched side is considered an unobstructed second side. The sloped side (20) clearly partially blocks a portion of the die opening (Fig. 1).

Conclusion

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 571-272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP
February 8, 2005

acy
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